

### **REMARKS**

Reconsideration of this application is requested.

The claims pending for examination are previously considered claims 1-3 and 6-14 and new claims 15-20.

The new claims have been added in view of the Examiner's newly raised objection to use of "optionally" with reference to possible substitution for the A and L substituents.

More specifically, new claims 15 and 16 define the optional substitution based on the applicants' disclosure at page 3, lines 3-11 for A (claim 15) and page 3, lines 28-32 for L (claim 16).

Claims 17 and 18 depend from claim 3 and define the A and L optional substituents in the same way as claims 15 and 16, respectively.

Claims 19 and 20 are specific to preferred A and L values based on the applicants' disclosure at page 3, lines 17-25 and lines 28-33.

For the Examiner's possible ease of reference, the applicants' claims can be grouped as follows:

- (1) claims 1, 2, 15, 16 and 19 are drawn to a process for printing an image using an ink-jet printer to apply a composition as defined;
- (2) claims 3, 17, 18 and 20 are drawn to compositions for ink-jet printing;
- (3) claims 6-9 are drawn to disazo compounds as defined;
- (4) claims 10 and 11 are drawn to specific uses of the applicants' composition of claim 3; and
- (5) claims 12, 13 and 14 are drawn to processes for preparing the compounds of Formula (1) as defined.

In the Examiner's current action, claims 10, 11 and 12 have been rejected only under Section 112, 2nd ¶, for use of the term "optionally". This objection has been dealt with in the foregoing amendments to the claims. Hence it is understood that claims 10-12 are free from the art and, as amended, should be allowable.

In the Examiner's prior action dated July 17, 2007, the Examiner had indicated the allowance of claims 1-3, 10 and 11 with claim 12 only objected to as dependent on a rejected claim (claim 6). Only claims 6-9 and 13 were rejected and these claims were rejected under Section 102(b) as anticipated by Budesinsky et al. U.S. 3,527,749 (identified as Vrzalova Dana et al.). In the current action, the Examiner has rejected claims 1-3, 6-9 and 13-14 under Section 103(a) as unpatentable over the aforementioned U.S. 3,527,749.

The Examiner has given no reason in the current action for the changes in his position in withdrawing the earlier allowance of claims 1-3 to reject the same as unpatentable over U.S. 3,527,749 and the Examiner has said nothing in his current rejection which deals with characterizing features of claims 1-3, i.e. printing an image using an ink-jet printer to apply the indicated composition (claims 1, 2) and a composition for ink-jet printing (claim 3). There is nothing in the Examiner's reference which is suggestive of the uses visualized and claimed by the applicants in claims 1-3 or, for that matter, any of the other claims herein.

Turning in more detail to the Examiner's action, it is to be noted that the references to "optionally substituted" have been deleted from the claims. Generic language has been used in the amended claims and new claims 15-20 recite specific substitution values based on the applicants' disclosure.

Reference to "optionally metallized" has been retained as this, of course, includes the nature of the optional variation (i.e. metallized).

In view of the amendments to the claims, the Examiner is requested to reconsider and withdraw the Section 112, 2nd ¶ rejection of claims 1-3 and 6-14. These claims, and all the other claims herein, are thought to be in acceptable form.

The Examiner is also respectfully requested to reconsider the Section 103(a) rejection of claims 1-3, 6-9 and 13-14 as unpatentable over "Vrzahlová Dana et al." (U.S. 3,527,749). The applicants' claims are not obvious from the Examiner's reference for reasons indicated below.

Initially, it is noted that in their response to the Examiner's previous action, the applicants amended claim 6 by deleting reference to heteroaryl from the definition of A. In making this amendment, the applicants pointed out that the compounds disclosed in U.S. 3,527,749 have at least one heteroaryl group in the form of the R group (and possibly R' which may be the same as R in embodiments). Thus, according to the general formula in Column 1 of the reference, all of the 7 groups listed as possible groups for R are clearly heteroaryl (i.e. they have a nitrogen atom forming part of the aromatic ring). Since the amendments to claim 6 define a compound B wherein each A is aryl (the option of heteroaryl being deleted), the applicants submitted that Vrzalova Dana et al. clearly did not anticipate.

The Examiner's current Section 103(a) rejection is set out in Section 3 (pages 3-4) of the action. In essence, the Examiner lists the compound structures shown in the Abstract of 3,527,749 (Col. 1, lines 16-55) and repeated again in the Summary of the Invention in Col. 2, lines 22-66). The Examiner then goes on to state, in essence, that the reference does not disclose the compounds expressly excluded by the

applicants' proviso (ii) of claim 1 and (iii) of claim 6. The Examiner concludes with the statement:

"Therefore it would have been obvious that disazo compound taught by Vrzalova Dana et al. don't have the compound claimed by the applicant."

The applicants respectfully submit that this statement by the Examiner actually confirms the applicants' position that the reference does not disclose or suggest the subject matter which is being claimed herein.

The applicants note that in rejecting the claims under Section 103(a), the Examiner has commented only on the exclusionary segments of the applicants' claims and has not commented in any way on the features which are recited positively and function to patentably distinguish the claims from the cited reference. Thus, applicants' process claims 1 and 2 clearly recite a process for printing by means of an ink-jet printer using the indicated disazo compounds. The reference, on the other hand, is concerned with a technical field completely unrelated to ink-jet printing and it is impossible to see how the reference disclosure can be relevant to the subject matter of claims 1 and 2. Significantly, in rejecting the claims, the Examiner has made no effort to comment on this clearcut deficiency of the reference disclosure.

Similarly, applicants' claim 3 relates to a composition (i.e. an ink) for ink-jet printing and claims 10 and 11 relate to paper and ink-jet printer cartridges respectively printed with or containing the ink-jet composition of claim 3. There is nothing remotely relevant to, or suggestive of, the composition of claim 3 in the Examiner's reference. The Examiner has recognized the patentability of claims 10 and 11 (as well as claim 12) over the citation and the same should be true for claim 3 (as well as the other claims herein).

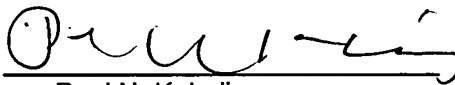
As for claims 6-9, these claims, as earlier noted, were previously amended in response to the Examiner's earlier rejection of claims 6-9, to clearly remove any option for A to be a heteroaryl group, i.e. each A group in the compounds of claims 6-9 must be an aryl group. In contrast, the Examiner's reference requires a group R which is in all its possible forms always a heteroaryl group and, therefore, outside the scope of the present claims. Clearly, there is no suggestion in the reference of any compounds as claimed by the applicants in claims 6-9. Furthermore, since the reference relates to a completely different technical field from ink-jet printing, the non-obviousness of the subject matter of claims 6-9 over that art is believed to be immediately apparent.

As for claims 13 and 14, also rejected under Section 103(a), the Examiner has not shown how the processes of these claims are in any way suggested by U.S. 3,527,749. With respect, it is submitted that there is nothing in the reference suggestive of the applicants' processes of claims 13 and 14 and these claims are clearly directed to subject matter which is not in any way obvious from the reference.

In short, the applicants respectfully submit, for the reasons noted, that the Examiner's Section 103(a) rejection of claims 1-3, 6-9 and 13-14 based on U.S. 3,527,749 should be withdrawn and the claims allowed. New claims 15-20 are thought to be allowable for the same reasons and should also be allowed.

Favorable reconsideration with allowance of all claims is requested. If the Examiner has any questions concerning the foregoing, he is requested to contact the undersigned at 202-739-5455.

Respectfully submitted,  
MORGAN LEWIS & BOCKIUS LLP

By   
Paul N. Kokulis  
Reg. No. 16773

Date: March 11, 2008

**Customer No. 09629**

1111 Pennsylvania Avenue, N.W.  
Washington, D.C. 20004  
Phone: (202) 739-3000  
Facsimile: (202) 739-3001  
Direct: (202) 739-5455